

Remarks/Arguments:

Claims 1-40 and 42-66 are pending, as claims 55-70 are added herein. In an Office Action dated August 26, 2004, the Examiner has rejected all claims as obvious over the following combinations: claims 1-6, 10-11, 13-20, 24-34, 38-40, 42-45, and 49-54 are rejected over the combination of Khurana (U.S. Pat. No. 6,735,489) with Henson (U.S. Pat. No. 6,167,383); claims 7-9, 21-23, 35-37, and 46-48 are rejected over the combination of Khurana, Henson, and Squilla (U.S. Pat. No. 6,288,719); and claim 12 is rejected over the combination of Khurana, Henson, and Chien (U.S. Pub. No. 2001/0054003). Of the pending claims, claims 1, 11, 13, 14, 29 and 39 are independent.

Claims 1, 11, 13, 14, 29, and 39 are amended herein with subject matter disclosed at least at page 3, lines 5-11 (decorative element) of the written description. Further amendments to these claims eliminate the dual nouns "designs and images" in favor of "images", and numerous dependent claims likewise eliminate that duality. New claims 55-66 recite subject matter disclosed at least in the written description at page 3, line 33 to page 4, line 3; and also at page 14, lines 8-25. New claims 68-70 recite subject matter disclosed at least at page 15, lines 10-26 of the written description.

The obviousness rejections are now addressed in light of claim 1 which is exemplary of the first issue to be discussed. Claim 1 recites in relevant part:

- (a) a user interface for enabling a user to access said graphics server for defining a desired image *to be placed on* a consumer product; and
- (b) a manufacturing subsystem for receiving data descriptive of said desired image, and for manufacturing, at said user station, at least one three-dimensional component of said consumer product to have said desired image *placed on it as a decorative element.*" (emphasis added)

Each of the independent claims save claim 13 recite the italicized portions above, for which "placed on it as a decorative element" is added herein by amendment to each of them. Claim 13 recites that a desired image is to decorate at least one component of a mobile station rather than to be placed on a consumer product.

The Office Action cites Khurana, col. 6, lines 23-64 as teaching or suggesting this subject matter. The Applicant contends that Khurana fails to teach or suggest an image that is to be placed on a consumer product or to decorate a mobile station, or a

manufacturing subsystem that manufactures a three dimensional component of a consumer product to have the desired image placed on it as a decorative element. The reasoning for both is related but independent.

Khurana is directed to a CAD/CAM software program in which a designer provides base features to which additional form features may be associated in a parent-child relationship. In the Khurana reference, changes made to the associated features need not affect other associated features. Khurana teaches printing process sheets and making a product from the CAD/CAM base and associated features.

The Office Action recites that Khurana's teaching of graphical models (col. 3 line 9 to col. 4, line 36, and Figs 1, 4 & 6) teach or suggest the claimed desired image. However, the Khurana CAD/CAM base and associated features are not "to be placed on" a consumer product (or "to decorate" a mobile station) as recited in the pending claims, but rather define the Khurana product itself. Whereas the claims recite a desired image that is to be placed on a product, the CAD/CAM base and associated features are to define the Khurana real-world parts, not to be placed on them. Therefore, Khurana cannot teach nor suggest an image to be placed on a component or to decorate a mobile station; its teachings as to CAD/CAM features are to define the actual forming of the Khurana real-world part itself, and are therefore not placed on it or decorate it.

Respecting physical products as distinguished from the on-screen virtual CAD/CAM base and associated features, Khurana is seen to teach only two: the 'real-world part' made from the CAD/CAM software, and process sheets 23 (Khurana col. 6, lines 49-60, an example given at Fig. 6). Each and every pending independent claim recites a manufacturing subsystem for manufacturing (or manufacturing in the case of the method claims) a three dimensional component, which is not seen to be taught or suggested by the Khurana process sheets, and the Office Action does not assert the process sheets as teaching such.

The Office Action recites that the Khurana real-world part made by automated machinery utilizing the CAD/CAM teaches or suggests the claimed three dimensional component, citing Khurana col. 6, lines 23-64.

Each and every independent claim is amended herein to recite that the three-dimensional component has the desired image placed on it as a decorative element. It is asserted that this is not a narrowing amendment, as the term 'desired image' draws antecedent basis from the image 'to be placed on' discussed above, and thereby already excluded CAD/CAM teachings by which parts are defined from features. This amendment is instead made to clarify by repetition the above distinction.

Khurana is not seen to teach or suggest a desired image placed on a component as a decorative element. To place an image on a component as a decorative element, as claimed, there must be some pre-existing component on which to place the image. Said another way, the component must exist independently of the image placed on it, and prior to the placing thereof. This is especially true when the image is placed on as a decorative element. Khurana is not seen to teach an image placed on a real-world part, but rather a real-world part and CAD/CAM features that are inseparable because the features define the part. Khurana is not seen to place an image such as those shown in Khurana Figs. 1 or 4-6 on the part as a decorative element.

The relation between the Khurana CAD/CAM features and a real-world part made from it is analogous to that between a set of blueprints and a resulting building. Teaching that a building may be made from the blueprints is not a teaching that the resulting building has the blueprints placed on it as a decorative element. To place the blueprints on the building as a decorative element presumes the existence of the building. Khurana does not teach or suggest making the real-world part according to the CAD/CAM features and subsequently placing an image of the CAD/CAM features on the already-made part, but the claims do recite placing a desired image on a component. That the CAD/CAM features are inherent in the Khurana real-world part is not a teaching of placing an image of the features on that same part. This is especially true in that each independent claim now reads that the image is placed on the component "as a decorative element", further removing the Khurana's CAD/CAM teachings from the claimed subject matter.

The Office Action further cites Henson against the independent claims. Henson is directed to a web-based online store by which a customer may order a custom-configured

computer machine that is assembled at a remote location. Henson is not seen as having teachings relevant to the above-detailed claim elements, and the Office Action does not cite it for such but rather for its teachings related to communicating over the Internet.

Therefore, neither Khurana nor Henson is seen to teach or suggest either of the two claim elements recited above. The relevant portions of those claim elements are present in each and every independent claim. For at least the above reasons, each and every independent claim is seen to be non-obvious over the asserted combination of art.

Claim 2 depends from claim 1 and recites that the user station further comprises an e-commerce engine for conducting a financial transaction with the user in order to make an accounting for the manufactured component. Claims 12, 15, 30 and 40 each recite similar or identical subject matter. The addition of the e-commerce engine of claims 2, 12, 15, 30 and 40 necessarily require that the user of the user station engage in some financial exchange or accounting for the consumer product. It is not seen how the combination of asserted references makes obvious the dependent claims that recite an e-commerce engine or similar. The asserted motivation to combine them, in order to make an accounting, is not understood and appears to improperly rely on hindsight gleaned from the present application. It is asserted that the Office Action fails to make a prima facie showing of obviousness vis a vis claims 2, 12, 15, 30 and 40, as there does not appear motivation within the references to combine a CAD/CAM platform with an on-line retail computer customization and ordering program.

Claim 10 recites that the user station comprises a POS (point-of-sale) terminal, as do claims 24, 38 and 49. The Office Action appears to conflate a home computer operating over an Internet customization and ordering program/web store with a POS terminal. The arguments with respect to claims 2, 12, 15, 30 and 40 are repeated as to claims 10, 24, 38 and 49. Because no reference or combination of them is seen to teach or suggest the claimed POS terminal, and motivation is not seen within the references to combine them as asserted, this group of claims is also seen to be non-obvious.

Claim 4 recites that a predetermined image is the desired image, and claims 18, 32 and 43 recite similarly. To this Henson is cited for teaching a predetermined computer

configuration. These claims previously recited design rather than image, so the rejection may be moot. If the Office Action implies that a computer system having a RAM storage volume A and a monitor of type B (e.g., standard view) is a different image than another of RAM storage volume A' and a monitor of type B', the Applicant contends that neither constitutes a consumer product having the "image" placed on it for the same reasons argued above related to the independent claims: a list of specifications by which a product is made does not teach placing a desired image on a component as a decorative element. Because no reference or combination of them is seen to teach or suggest the above claim element, claims 4, 18, 32 and 43 are seen as non-obvious over the combination of art.

Claims 7, 21, 35 and 46 recite the user inputs a new image by digitally scanning an image, and claims 8, 22, 36 and 47 recite the user inputs a new image from a digital camera. Another group of claims relate to a memory card as providing the new image. The Office Action adds the teachings of Squilla to these groups of dependent claims, which is directed to a system and method for constructing a photo album. It is not seen how providing an image via digital scan or camera operates in conjunction with the CAD/CAM software of Khurana to make obvious the claims of these two groups. Is the provided image converted into a template that is then used by the CAD/CAM software? The references provide no support for such a conversion, as Squilla merely uses the digital image to print a photograph, not to manufacture a component with the digital image placed thereon. It is not seen how these references may be combined consistent with their teachings and motivations, let alone in a manner that makes obvious the specific claimed matter of these groups of claims. Because no reference or combination of them is seen to teach or suggest the above claim element, this group of claims is seen to be non-obvious.

The last group of dependent claims relate to the consumer product being a mobile station (claim 25), where the manufactured three dimensional component comprises a cover for a mobile station (claims 26 and 50-54), the user selects/modifies/creates an audible signal for use with it (claim 27, e.g., a ring tone), and the user selects/modifies/creates a graphical image for use with it (claim 28). Each of these is rejected as obvious over Khurana and Hansen. Taken in reverse, Hansen's reference to a chassis (col. 15, lines

31-41) is not seen relevant to a graphic image as in claim 28; no graphic image is seen to be placed on the computer of Henson or on the part defined by the Khurana CAD/CAM features. If the Office Action purports to suggest that the Hansen computer chassis or the part defined by the Khurana CAD/CAM features exhibits a graphic image by their very shape, the Applicant asserts that either interpretation reads the term graphical image (which is clearly described in the written description) out of claim 28 and fails to render it obvious, over any reference alone or in combination.

Claim 27 clearly recites an audible signal, not means for producing an audible signal. The sound card and speakers of Hansen (Fig. 5) are hardware. Hansen is not seen to teach or suggest the user can select/modify/create an audible signal for use with the part defined by the Khurana CAD/CAM features that was asserted as obvious against claim 14 (from which claim 27 depends). Claim 27 is therefore asserted as non-obvious over the references alone or in combination.

Hansen's cited teaching of a choice in computer monitors (Fig. 5, "monitor choose") is also seen to be irrelevant to the claimed mobile station or cover of claims 25, 26 and 50-54. The Applicant interprets the Office Action reasoning surrounding claim 13 as implying that because it is known to make a laptop computer or PDA with certain functions traditionally associated with a personal computer, then the teachings relevant to a personal computer apply equally to a mobile station. True or not, the assertion is not seen to be relevant at least because Hansen fails to teach or suggest that a cover for a personal computer may be customized by the user with new, modified, or pre-existing graphic images. Even if Hansen taught this explicitly, the assertion of obviousness against the independent claims relies on the CAD/CAM software as providing the image placed on that cover. While Hansen may teach that a user can select from among several computer monitors, it is not seen where any of those monitors are made with the desired image placed on them. If the Office Action means to imply that an image displayed on the monitor makes obvious placing a desired image on the component, it is not seen where Henson teaches that the user defines the desired image as recited in the independent claims. Because no reference or combination of them is seen to teach or suggest the above claim elements, this group of claims is also seen to be non-obvious.

Respecting new claims 55-66, no reference is seen to teach or suggest checking modified or new images for trademark.

The Applicant has now argued the novelty and non-obviousness of this invention over numerous references and numerous searches. The present primary reference to Khurana is seen to lack teachings relevant to two different elements present in each of the independent claims, which are not cured by any other reference and which carry through to undermine further asserted combinations against many of the dependent claims. The Applicant respectfully submits that each and every one of the pending claims patentably distinguishes over all art cited in this and in the numerous previous Office Actions, and requests a favorable decision for allowance of all claims without further delay. The Applicant's undersigned representative invites the Examiner to discuss or clarify any remaining concerns via teleconference, at the Examiner's discretion.

Respectfully submitted:



Gerald J. Stanton
Reg. No.: 46,008

December 22, 2004

Date


Customer No.: 29683
HARRINGTON & SMITH, LLP
4 Research Drive
Shelton, CT 06484-6212
Phone: (203) 925-9400
Facsimile: (203) 944-0245
Email: gstanton@hspatent.com

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

December 23, 2004

Date


Ann Okrentowich